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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,649	03/30/2001	Edward Soh Smith	RPA1006	8561

22829 7590 04/24/2002

ROCHE MOLECULAR SYSTEMS INC  
PATENT LAW DEPARTMENT  
1145 ATLANTIC AVENUE  
ALAMEDA, CA 94501

EXAMINER
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GUNTER, DAVID R

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 04/24/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/823,649

Applicant(s)

SMITH ET AL.

Examiner

David R. Gunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 8-13, 20-29, 36-41, and 48-52 drawn to a method for the reverse transcription of RNA using a DNA polymerase identified by SEQ ID No.: 1, classified in class 435, subclass 91.51, encompass a number of distinct inventions defined by the multiple amino acid sequences of SEQ ID No.:1.
- II. Claims 2, 14, 30, and 42 drawn to a method for the reverse transcription of RNA using a DNA polymerase identified by SEQ ID No.: 2, classified in class 435, subclass 91.51, encompass a number of distinct inventions defined by the multiple amino acid sequences of SEQ ID No.:2.
- III. Claims 3, 15, 31, and 43 drawn to a method for the reverse transcription of RNA using a DNA polymerase identified by SEQ ID No.: 3, classified in class 435, subclass 91.51, encompass a number of distinct inventions defined by the multiple amino acid sequences of SEQ ID No.:3.
- IV. Claims 4, 16, 32, and 44 drawn to a method for the reverse transcription of RNA using a DNA polymerase identified by SEQ ID No.: 4, classified in class 435, subclass 91.51, encompass a number of distinct inventions defined by the multiple amino acid sequences of SEQ ID No.:4.

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V. Claims 5, 17, 33, and 45 drawn to a method for the reverse transcription of RNA using a DNA polymerase identified by SEQ ID No.: 5, classified in class 435, subclass 91.51, encompass a number of distinct inventions defined by the multiple amino acid sequences of SEQ ID No.:5.

VI. Claims 6, 18, 34, and 46 drawn to a method for the reverse transcription of RNA using a DNA polymerase identified by SEQ ID No.: 6, classified in class 435, subclass 91.51, encompass a number of distinct inventions defined by the multiple amino acid sequences of SEQ ID No.:6.

VII. Claims 7, 19, 35, and 47 drawn to a method for the reverse transcription of RNA using a DNA polymerase identified by SEQ ID No.: 7, classified in class 435, subclass 91.51, encompass a number of distinct inventions defined by the multiple amino acid sequences of SEQ ID No.:7.

Inventions I - VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions each use a distinct DNA polymerase. The polymerases used each vary in their amino acid sequence, physical properties, or organism of origin as described above. Amino acid sequences defining different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent

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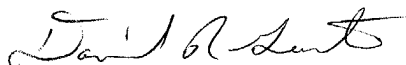
and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each amino acid sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.

Applicant is to elect a single amino acid sequence in which every amino acid is identified without ambiguity.

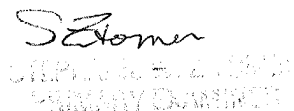
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. Gunter whose telephone number is (703) 308-1701. The examiner can normally be reached on 9:00 - 5:00 M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.



David R. Gunter, DVM, PhD  
April 16, 2002



STOMER  
JUL 16 2002  
PRIMARY EXAMINER